

REMARKS

Claims 1-30 are pending in this application. Claims 1-30 stand rejected. By this Amendment, claim 4 has been amended. The amendments made to the claims do not alter the scope of these claims, nor have these amendments been made to define over the prior art. Rather, the amendments to the claims have been made to improve the form thereof. In light of the amendments and remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance. As such, Applicant respectfully requests reconsideration and withdrawal of all pending rejections and objections and allowance of the claims.

The Office Action notes that the drawings are objected to by the Draftsperson as indicated on Form PTO-948. However, no PTO-948 form was included with the Office Action. Applicant's representative contacted the Examiner who stated that he did not believe that a Form PTO-948 was issued indicating an objections by the Draftsperson. As such, Applicant respectfully requests that the objection to the drawings be withdrawn.

The specification is objected to, particularly to the phrase "continues until from step 222" on page 12, line 14. Applicant has amended the specification to correct for this typographical error. The phrase now reads "continues from step 222". As such, Applicant respectfully requests that this objection be withdrawn.

Claims 1, 19, 24, 26, and 28 have been rejected under 35 U.S.C. § 101 as being “directed to non-statutory subject matter.” In particular, the Office Action contends that the claims are “not supported by either a credible asserted utility or a well established utility”. The Office Action further contends that claims 1, 19, 26, and 28 are not “within the technological arts” Applicant respectfully traverses this rejection.

The fact that claims 1, 19, 24, 26, and 28 meet the useful, concrete and tangible result requirement for patentable subject matter under 35 U.S.C. § 101 is inherently admitted in the Office Action. As far as Applicant is aware, meeting of this test alone satisfies the requirement under Section 101.

As stated in *State Street Bank & Trust Company v. Signature Financial Group, Inc.*, 47 USPQ 2d 1596, 1601-02 (Fed. Cir. 1998), a claim satisfies the requirements of Section 101 if “the practical application of the abstract idea produces a useful concrete and tangible result.” Applicant had previously submitted selected pages of the training materials with respect to Section 101 prepared by the United States Patent and Trademark Office. These training materials enforce that the current state of the law, as enunciated in *State Street*, is the “useful concrete and tangible result” test. Nothing more is required.

Applicant is unaware of any further test as indicated in the Office Action such that “ “[b]ecause the claims are not claimed to be practiced on a computer and/or stored on a computer readable medium, they are not limited to practical applications in the technological arts.” This test is neither specified in the statute, the Code of Federal Regulation, nor the currently applicable law of the United

States. Significantly, this test has never been required by the courts. In applying this test the Office Action states that the claims are “not limited to the technological arts” and, apparently that the method could be carried out completely by hand (i.e., entirely by a human). Applicant respectfully submits that this test is quite contrary to long standing law and it is irrelevant whether the steps of the claims can be carried out by hand.

Steps carried out by humans are okay if they satisfy the useful, concrete and tangible result test. Specifically, in *In re Musgrave*, 431 F. 2d 882, 893; 167 U.S.P.Q. 280, 289 (CCPA 1970), the court expressly stated that a method remains statutory even if all of the steps therein can be carried out in the human mind.

In fact, Applicant respectfully submits that the present invention is clearly within the definition of patentable subject matter or “technical arts” that is stated in the Office Action. The United States Supreme Court has stated that patentable subject matter has been interpreted to be “anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303 (1980). What may not be patented has been identified by the Supreme Court as “laws of nature, natural phenomena, and abstract ideas.” *Id.* at 185. The present invention is not claiming any of these non-patentable subjects. In addition, there has been no requirement by the courts of the United States that method claims can not be entirely carried out by hand, nor has the Examiner cited any cases stating such a requirement.

Claim 24 is separately objected to as being directed towards non-statutory subject matter for claiming a “carrier medium”. Applicant notes that computer programs embodied in a tangible medium such as floppy, diskettes, or other carrier

medium are patentable subject matter under 35 U.S.C. § 101 and must be examined under 35 U.S.C. §§ 102 and 103. *See, In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995). As such, claim 24 is directed to statutory subject matter and the objection under 35 U.S.C. § 101 should be withdrawn.

As such, the currently pending claims clearly satisfy the requirements of 35 U.S.C. § 101. Accordingly, this rejection must be withdrawn as there is no reasonable basis to apply it in the present case.

Claims 1, 19, 24, 26, and 28 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement. The Office Action asserts that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or which it most nearly connected, to make and/or use the invention. Applicant respectfully requests that the Examiner withdraw this rejection. Applicant's claims are directed to methods for forming a set of rules representing a situation. The claims are statutory subject matter and, as such, are enabled for one skilled in the art to practice said claims. As such, Applicant respectfully requests that this objection be withdrawn.

Claim 4 stands rejected under 35 U.S.C. § 112, second paragraph. Applicant has amended claim 4 to correct for a typographical error. As such, Applicant respectfully requests that the rejection to claim 4 be withdrawn.

Claims 16, 17, 24, and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,719,692 ("Cohen"). Applicant respectfully requests reconsideration and withdrawal of this rejection.

To anticipate a claim under 35 U.S.C. § 102, the cited reference must disclose every element of the claim, as arranged in the claim, and in sufficient detail to enable one skilled in the art to make and use the anticipated subject matter. *See, PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998). A reference that does not expressly disclose all of the elements of a claimed invention cannot anticipate unless all of the undisclosed elements are inherently present in the reference. *See, Continental Can Co. USA v. Monsanto Co.*, 942 F.2d 1264, 1268 (Fed. Cir. 1991).

According to Applicant's claims, there is a "first code section executable to find within a collection of data related to said situation a representative collection of data comprising attribute patterns and associated conclusions." This limitation is not present in the Cohen reference. Cohen uses a rule-base system that removes data does not conform to a current rule that is set. In contrast, Applicant's claims require that attribute patterns of data are associated and that irrelevant attribute elements are removed. As such, Cohen fails to anticipate Applicant's claims 16, 17, 24, and 25. As such, Applicant respectfully requests that the rejection to those claims be withdrawn.

Claim 18 stands rejected as being anticipated by U.S. Patent No. 6,047,279 ("Barrack"). Applicant respectfully requests reconsideration and withdrawal of this rejection.

Among the limitations of Barrack not present in the cited reference is a processor coupled to said network and operable to manipulate the data records to form a representative collection of attribute patterns and associated conclusions. The Office Action cites to column 2, lines 55-67 to disclose this feature. However, Applicant respectfully asserts that this feature is not present in the cited portion of Barrack. At no point is the manipulation of the set of data records to form a representative collection of attribute patterns present. This portion of Barrack utilizes if/then statements to manage network management systems without forming a representative collection of attribute patterns. As such, Applicant respectfully submits that claim 18 is allowable over the Barrack reference.

Claim 19 stands rejected as being anticipated by U.S. Patent No. 6,006,213 (“Yoshida”). Applicant respectfully requests reconsideration and withdrawal of this rejection.

Among the limitations of independent claim 19 not present in the Yoshida reference is the step of identifying at least one attribute in each fact pattern that contributes to a respective conclusion associated with said fact pattern. Yoshida merely analyzes the frequency of a pattern appearing on a graph, extracting the pattern and outputting a pattern having a “good evaluation result”. However, this does not entail identifying at least one attribute in each fact pattern that contributes to a respective conclusion associated with said fact pattern as explicitly recited in Applicant’s claim. As such, Applicant respectfully asserts that claim 19 is allowable over the Yoshida reference.

Claims 1-15, 20, 23, 26-27, and 29-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshida in view of Cohen. Applicant respectfully requests reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, *In re Hummer*, 113 U.S.P.Q. 66 (C.C.P.A. 1957); *In re Stencel*, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

With respect to claims 1, 10, and 26, the Examiner admits that Yoshida does not explicitly teach removing irrelevant attribute elements. The Examiner uses Cohen to attempt to cure this deficiency. However, as noted above with respect to claim 16, Cohen does not properly teach comparing a selected attribute pattern to all other attribute patterns and removing irrelevant attribute elements from selected attribute patterns. As Cohen does not cure this deficiency, claims 1, 10, and 26 are allowable.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

By


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